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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,174

03/03/2006

Frederic Fortin

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11/04/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

FISHER, ELANA BETH

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

11/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,174	Applicant(s) FORTIN ET AL.	
	Examiner ELANA B. FISHER	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/17/2009; 09/24/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 17, 2009 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 13 recites the limitation "the positions" in the fifth line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 13 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Atkinson et al. (U.S. Patent 6,402,750).

Atkinson et al. disclose a device comprising: a first rod member (112) having a first end (FIG 10C; end of 112 in contact with 113); a second rod member (114) having a second end (115); a mechanical coupler (threading; FIG 10C) connecting the first rod

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member to the second rod member and allowing adjustment of the positions of the first rod member and the second rod member such that a distance between the first end of the first rod member and the second end of the second rod member can be controlled to straighten the spine of a patient, wherein at least one of the first rod member (112) and the second rod member (114) is serrated (FIG 10C), and wherein the first rod member and the second rod member are curved (FIG 10A). Additionally, Atkinson et al. disclose that the device comprises a first damping member (111), having a first end coupled to the first end of the first rod member (112; FIG 10C) and a second end (115) configured to be coupled to a vertebra.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortin (WIPO Publication 2000/72768 A1) in view of Navas (U.S. Patent 5,375,823).

Fortin discloses a device comprising: a first rod member (35) having a first end (38); a second rod member (36) having a second end (39); a mechanical coupler (300) connecting the first rod member to the second rod member and allowing adjustment of the positions of the first rod member and the second rod member such that a distance between the first end of the first rod member and the second end of the second rod member can be controlled to straighten the spine of a patient, wherein at least one of the

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first rod member (35) and the second rod member (36) is serrated (FIG 14), and wherein the first rod member and the second rod member are curved (FIG 14). Additionally, the second end (39) includes a hook member configured to engage a rib (FIG 14).

However Fortin fails to disclose first and second dampening members coupled to the first and second ends (38, 39) of the first and second rod members (35, 36). Navas discloses a device comprising a rod member (30) having a dampening member (1), with a first end of the dampening member (1) coupled to a first end of the rod member (FIG 2) and a second end of the dampening member (11) configured to be coupled to a first bone structure (FIG 4), wherein the damping member comprises: a rigid cylinder; a first elastic member (4) disposed within the rigid cylinder; and a second elastic member (6) disposed within the rigid cylinder, wherein the first end of the first rod member (30) includes an enlarged distal portion (3) disposed between the first elastic member and second elastic member (FIG 2). It therefore would have been obvious to one skilled in the art to modify the device taught by Fortin, by having a dampening member attached to the first and second ends (38, 39) of the first and second rod members (35, 36) as is taught by Navas, because the dampening device is capable of being used in combination with a prosthesis system (Navas, Column 3, lines 58-65) for providing the advantage of aiding in dampening stresses and strains experienced by intervertebral discs when they are withstanding compression and traction forces (Navas, Column 3, lines 43-45) that occur during the operation of the device and during bodily movements, when the device is connected to vertebrae and/or the rib cage. Furthermore, the rigid rods taught by Fortin do not provide means of dampening the stress and strain experienced by the intervertebral

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discs and bodies; therefore use of the dampening device taught by Navas in combination with the rigid rods taught by Fortin allows for the problem presented by Fortin to be overcome.

Response to Arguments

8. Applicant's arguments filed August 17, 2009 have been fully considered but they are not persuasive.

In combining the Fortin and Navas references, examiner has looked to overcome a problem posed by Fortin's device via the use of Navas's device. Fortin provides correction to a spinal deformity. In the process of the correction the rods are used to maintain the spinal column in a specific location, however the rods do not provide any means of relieving stress and strain placed on intervertebral discs and bodies. Navas overcomes this problem of diminishing pain on vertebrae that are succumbed to a stabilization process, by providing a dampening system. Accordingly, regardless of the intended placement of Navas's device, it is used to solve the problem that Fortin poses and needs to be overcome.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELANA B. FISHER whose telephone number is (571)270-3643. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:00PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571)272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elana B Fisher/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733